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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,366	09/25/2003	Jean Prevost	SWAB:006B	3376
6160	7590	01/24/2005	EXAMINER	
PARKHURST & WENDEL, L.L.P. 1421 PRINCE STREET SUITE 210 ALEXANDRIA, VA 22314-2805			ARYANPOUR, MITRA	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/669,366

Applicant(s)

PREVOST ET AL.

Examiner

Mitra Aryanpour

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claims 18-21 are directed to an invention that is independent or distinct from the invention claimed in the original patent. See MPEP §1450.

I. Claims 1-15, drawn to a synthetic grass turf-marking strip, classified in class 473, subclass 490.

II. Claims 18-21, drawn to a method of marking lines in a natural grass turf, classified in class 428, subclass 87.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions are distinct because the process for using the product as claimed can be practiced with another materially different product such as without the aid of a pair of elongate flexible turf anchoring strips laterally outward of the outer bands of ribbons and secured to the backing. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. Since applicant has received an action on the merits for the originally presented invention, in the original patent, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 18-21 are withdrawn from consideration as being directed to a non-elected invention. See MPEP §1450.

***Oath/Declaration***

4. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414. The statement that “it was realized that it was not necessary to restrict that color to green” is not considered to be an error.

5. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

***Recapture***

6. Claims 1-15 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. A recapture exists since the omitted, claim limitation [ribbons of a second color] no longer obviates the art rejection.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Eley (4,103, 886) in view of Friedrich et al. (4,755,401).

Regarding claim 1, Eley shows a synthetic grass turf marking strip (20) for visually marking lines in a natural grass turf surface when embedded within a shallow trench (Column 2, lines 52-55) cut into the natural grass turf surface, the marking strip comprising: an elongated flexible sheet backing (22), an underside of the backing comprising a trench bedding surface; parallel rows of synthetic ribbons (Fig. 4), extending upwardly from a top surface of the backing a pile height sufficient to extend a selected distance above the trench, the ribbons are usually white or any other highly visible color (Column 2, lines 17-19). Eley further shows a pair of elongated flexible turf anchoring strips laterally outward of the outer bands of ribbons and secured to the backing (Column 2, lines 41-45); the turf marking strip has a ballast means on the backing for securing the marking strip within the trench; and the ballast means comprise granular material disposed between the parallel rows of synthetic ribbons (Column 2, lines 61-64). Eley does not expressly disclose whether the base (22) positioned on either side of the stems (26) is of a second color. Friedrich et al, shows rows of ribbons including a middle band (12) of ribbons of a first line color and a pair of outer bands (10) of ribbons of a second line color laterally adjacent the middle band (Column 3, lines 25-35). In view of Friedrich et al, it would have been obvious to one of ordinary skill in the art to have made Eley's line marker, a two-color line marker the

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motivation being in order to make Eley's line marker visually distinguishable during installation and when in use.

9. Claims 2-6, 8, 9, 10, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eley (4,103, 886) and Friedrich et al (4,755,401) as applied to claims 1, 16 and 17 above, and further in view of Bergevin (5,586,408).

Regarding claims 2-6, 8 and 9, Eley as disclosed above lacks an anchoring means comprising an open weave fabric and a bonding means with a plurality of perforation for better interconnecting with roots of the turf. Bergevin shows anchoring strips that includes bonding means for interconnecting with roots of the turf; wherein the bonding means comprises a plurality of perforations (Column 3, lines 57-67) in the anchoring strips (Fig. 3); and the anchoring strips comprise an open weave fabric (Column 4, lines 59-67). Bergevin further shows that the granular material consists of particles selected from the group consisting of, sand, crumb rubber, gravel, granulated plastic and cork granules (Column 3, lines 12-16 and Column 8, lines 28-32); the granular material comprises a mixture of silica and ground crumb rubber (Column 8, lines 7-14); the backing comprises a fabric through which the ribbons are tufted (Column 4, lines 41-47). It would have been obvious to one of ordinary skill in the art in view of Bergevin to incorporate the new and improved backing of Bergevin with the field marker of Eley in order to provide better drainage and stability with the surrounding turf.

Regarding claim 10, Eley as modified above does not expressly show the use of needle-punched fabric for the backing. However, both woven and needle punched fabrics are well known means of providing backing and are considered to be art recognized equivalent, and it would have been obvious to use either one here, in order to secure the backing to the anchoring strips.

Regarding claims 13 and 14, Eley shows the ribbons to be made of flexible material such as natural or synthetic rubber or polycraton plastic material that is moldable. However, Eley as disclosed above does not specify the specific materials available for use.

Bergevin shows the ribbons consisting of fibers such as polypropylene and polyolefin fibers. Bergevin further shows the parallel rows of ribbons spaced apart at a predetermined distance, and the parallel rows of ribbons have a pile height about 1-½ inches. (Column 5, lines 35-47 and Column 6, lines 2-9). It would have been obvious in view of Bergevin to have selected anyone of the above art recognized equivalent materials for use with the line marker of Eley depending on its availability at the time of the invention. Regarding the height and spacing of the ribbons, one of ordinary skill in the art would appreciate the predetermined spacing and height of the ribbons in order to create a clear and safe turf marker.

10. Claims 7, 11, 12, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eley (4,103, 886), Friedrich et al (4,755,401) and Bergevin (5,586,408) as applied to claims 1, 5, 8 and 9 above, and further in view of Haas, Jr (4,044,179).

Regarding claims 7, 11 and 12, Eley as modified above uses fine soil for securing the line markers in the trenches. Eley does not expressly disclose the particular size of the particles. Eley also does not disclose the use of coating means on the backing. Haas, Jr shows an artificial turf-like product for the playing surface marked with lines and secured by putting down a layer of crushed rock or porous gravel to facilitate subsurface drainage; a woven or knitted pile fabric (20) with a relatively flexible backing that is moisture-impermeable; a layer of granular material is positioned on the pile fabric; the granular material consists of particles ranging in size of fine sand (between 40 to 200 screen mesh size), medium sand (between 20 to 70 screen mesh size), and the coarse sand (between 12 to 40 screen mesh size)-(see column 4, lines 58-68 and column 5, lines 1-7). In view of Haas, Jr, it would have been obvious to one of ordinary skill in the art to

have incorporated granule's of various sizes to secure Eley's field marker base strip, since the mixture of various size granules improves the moisture retention characteristics of the product.

Regarding claim 15, Eley does not disclose expressly the use of time-release growth inhibitors on the backing. The use of growth inhibitor materials are well known in the backing art. A few representative examples are Abscincic acid and ethylene are examples of systemic growth inhibitors. Other examples of growth inhibitors include: aluminum sulfate,  $\text{Al}^{+3}(\text{SO}_4)_2 \cdot 18\text{H}_2\text{O}$ ; or any one or more of the various alums which are hydrated double sulfate salts of monovalent metals, such as potassium, sodium, and ammonium, and trivalent metals, such as aluminum, iron, and chromium. A few typical and preferred examples of such alums are: potash alum,  $\text{K}^{+}(\text{SO}_4)_2 \cdot \text{Al}^{+3}(\text{SO}_4)_2 \cdot 24\text{H}_2\text{O}$ ; ammonium alum,  $(\text{NH}_4)^{+}(\text{SO}_4)_2 \cdot \text{Al}^{+3}(\text{SO}_4)_2 \cdot 24\text{H}_2\text{O}$ ; and sodium alum,  $\text{Na}^{+}(\text{SO}_4)_2 \cdot \text{Al}^{+3}(\text{SO}_4)_2 \cdot 24\text{H}_2\text{O}$ . based on the above teachings it would have been obvious to include a growth inhibitor on Eley's backing the motivation being to further reduce the natural grass growth.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA  
19 January 2005



**MITRA ARYANPOUR**  
**PRIMARY EXAMINER**